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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,623	10/07/2003	Michael David Newton	3315/29	5546

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Intellectual Property Department
DEWITT ROSS & STEVENS, S.C.
Excelsior Financial Center
8000 Excelsior Drive, Suite 401
Madison, WI 53717-1914

EXAMINER

MAUST, TIMOTHY LEWIS

ART UNIT	PAPER NUMBER
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3751

MAIL DATE	DELIVERY MODE
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06/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/680,623

Applicant(s)

NEWTON, MICHAEL DAVID

Examiner

Timothy L. Maust

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/509,265.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings filed on 10/7/03 are informal, since the numbers and lead lines are not uniform in nature throughout Figures 1A-6. In order to avoid abandonment of this application, corrected formal drawing are now required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson.

In regard to claims 1 and 6, the Jackson reference discloses a pneumatic control system containing at least one "inflatable/deflatable article" (defined by a tire), comprising:

a "control means" (defined by reader 4 controlling a two-way valve to inflate or deflate the article; page 4, line 23 - page 5, line 15) to operate the "pump" (defined by a compressor; page 4, line 25), a "connection means" (defined by the tire valve and mounting head 8), "communication means" provided on the tire (defined by a bar code on the valve; see abstract) and a communication means provided on the pump (reading

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head 4A in mounting head 8, figure 1.) When the valve is placed into the valve reader information is exchanged and the pump identifies the tire and inflates the tire to its correct pressure (page 6, lines 5-8.)

In regard to claim 2, the communication means is capable of exchanging information. The valve contains a bar code which the reader observes and then inflates the article accordingly. In pages 3-4; beginning on line 25, page 3 and terminating on line 3, page 4 this process is described, however this passage describes the embodiment using the tire cap.

In regard to claims 3 and 5, the communication means is provided within the connection means as either the bar code or reading head (see Figure 1).

In regard to claim 4, if the tire valve is taken to be the communication means on the article and the reader on the pump is taken to be the second communication means and these communication means use magnetic energy or a bar code reader as suggested in the third paragraph of the first page, the tire valve and the reader would not come into physical contact at anytime during the inflation/deflation process.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 7-11, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Benimeli.

In regard to claims 1, 2, 4 and 7-11, the Benimeli reference discloses a "pneumatic control system" (see Figure 4) comprising:

a "control means" (defined by a microprocessor) to operate the "pump" (defined by an inherent compressor to deliver air), a "connection means" (defined by the tire valve 1 and mouthpiece 18), "communication means" (defined by RF emitter 30 and RF receiver 35), as claimed (see column 8, line 20 – column 9, line 40).

In regard to claim 22, the tire is capable of being used as a "seat pad".

In regard to claim 23, any structure on the system that can be handled by a user can be defined as a "support mechanism".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benimeli.

The Benimeli reference discloses the invention substantially as claimed (discussed supra), but doesn't disclose the communication means being in the defined locations. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the communications means in the defined

areas as claimed, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,884,255.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims define an apparatus that anticipates the now claimed subject matter. Examiner takes Official Notice that anticipation falls well within the definition and scope of obviousness. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have claims drawn

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to the now claimed subject matter in view of Examiner's Noticed fact. Furthermore, Applicant's attention is directed to In re Goodman cited above in support of Examiner's position.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Cited prior art pertains to various pneumatic control systems, similar to Applicant's claimed device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy L. Maust whose telephone number is (571) 272-4891. The examiner can normally be reached on Mon. - Thur. 6:30 - 5:00.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy L Maust/
Primary Examiner
Art Unit 3751

Tlm
6/6/07